

REMARKS

Claims 10 and 12 were canceled. Claims 3, 6-8, 13-15, 17-19, and 25-28 are as originally filed. Claims 20, 22-24 and 29-32 are withdrawn, and claims 21 and 33 are withdrawn-currently amended.

Claims 1, 2, 4, 5, 9, 11, and 16 are currently amended. New claim 34 was added. Support for claim 34 can be found in original claims 10 and 12. No new matter has been introduced with these amendments.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1-19 and 25-28 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. In particular, the Office asserts that the term “pseudohalo” is “not defined in the specification.” (Office Action p. 2, l. 20-21) Applicants respectfully disagree and note that the term “pseudohalo” is fully defined in the specification at page 16, lines 2-5. The definition there states:

“As used herein, pseudohalides or pseudohalo groups are groups that behave substantially similar to halides. Such compounds can be used in the same manner and treated in the same manner as halides. Pseudohalides include, but are not limited to, cyanide, cyanate, thiocyanate, selenocyanate, trifluoromethoxy, and azide.”

Nevertheless, in order to expedite prosecution, Applicants amended the claims to replace the term “pseudohalo” with the definition from the specification. No new matter has been added. Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph rejections of claims 1-19 and 25-28.

Rejections under 35 U.S.C. § 112, second paragraph

A. Claims 1-19 and 25-28 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. The Office cites M.P.E.P. § 2173.05(c), and argues that “a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite...” (Office Action p. 3, l. 4-7) Specifically, the Office asserts that the recitation “all of which may be optionally substituted with one to ten substituents” falls within the broader recitation “optionally substituted alkyl... or optionally substituted cycloalkyl” and thus renders the claim indefinite (Office Action p. 3, l. 14-18). Applicants have herein amended the definition of substituents R³¹, R³², R³³ and R³⁴ to

clarify that the optionally substituted groups, when substituted, are substituted with one to ten substituents each independently selected from a group consisting of oxo, halo, etc. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph rejections of claims 1-19 and 25-28.

B. Claims 1-7, 9, 11, 13-14, 16-18, and 25-28 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for reciting what is not being claimed. The Office asserts that “several lines of definitions for R25 as what are not claimed [renders] the claim confusing and not clear.” (Office Action p. 3, l. 21-22).

Applicants respectfully disagree and direct the Office to M.P.E.P. § 2173.05(i), which recites the following:

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph.

Applicants submit that the negative limitation in the claims is clear and definite, and has basis in the original disclosure, and as such is in accordance with M.P.E.P. § 2173.05(i). There is no question what matter is being claimed. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph rejections of claims 1-7, 9, 11, 13-14, 16-18, and 25-28.

Objection

The Office objected to claims 1-19 and 25-28 for containing non-elected matter. Applicants respectfully request withdrawal of the claim objections and full search of the claimed scope pursuant to MPEP § 803.02 and § 809.

Claim 1 is a generic claim. Applicants respectfully request the Office expand examination of the claims to the non-elected portion of the generic claims, which, in the present instance, is the full scope of all claims pursuant to M.P.E.P. § 809.

As set forth in M.P.E.P. § 809:

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the claims of the application to one would be proper, but presented in the same case are one or more claims (generally called ‘linking’ claims) which, if allowable, would require rejoinder of the otherwise divisible inventions. See MPEP § 821.04 for information pertaining to

rejoinder practice. ... The most common types of linking claims which, if allowable, act to prevent restriction between inventions that can otherwise be shown to be divisible, are (A) genus claims linking species claims . . . The linking claims must be examined with, and thus are considered part of, the invention elected. When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement must be withdrawn. Any claims(s) directed to the non-elected invention(s), previously withdrawn from consideration, which depends from or requires all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability.

(Emphasis added.)

The present application presents Markush claims, and the proper procedure for examining Markush claims is set forth in M.P.E.P. § 803.02:

A Markush-type claim may include independent and distinct inventions. ... In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits. ... Following election, the Markush-type claim will be examined fully with respect to the elected species **and further to the extent necessary to determine patentability.** If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush-type claim drawn to the compound X-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, XA, XB, XC, XD, or XE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be **anticipated or rendered obvious by prior art**, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration.

On the other hand, should the examiner determine that **the elected species** is allowable, the examination of the Markush-type claim will be extended. **If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species**, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to **exclude the species anticipated or rendered obvious by the prior art**, the amended Markush-type claim will be reexamined. The examination will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action can be made final unless the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on

information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

(Emphasis added.) The applicants submit that following MPEP 803.02 and 809, a search of a Markush claim (which may include independent and distinct inventions) is to begin with the elected species and, if the species is allowable over the prior art, expanded to the full scope of the claims allowable over the prior art. The search may be stopped short of the full scope only if prior art is found that renders the claims unpatentable as anticipated or obvious; rejections under 35 USC § 112 are not a proper basis for limiting the search to the elected species. This is consistent with the policy of compact prosecution (e.g., MPEP 707.07(g) and MPEP 2106(II), which requires simultaneous examination of the claims as to all bases of patentability.

Applicants respectfully request the Office to search the claims to the scope permitted by the prior art, up to the full scope of the claims. Should prior art be identified, a non-final action would be appropriate to permit the applicants an opportunity to amend the claims and/or argue in favor of patentability. If the prior art rejection is thereby overcome, the search should be expanded once again, as is consistent with the example provided in MPEP § 803.02 and 809.

Finally, claims 29-33, which are directed to method of use, currently stand withdrawn from consideration as being drawn to non-elected invention. In accordance with MPEP §821.04(b), however, if Applicants elect claims directed to a product which is subsequently found allowable, the withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder. Upon rejoinder of claims directed to a previously non-elected process invention, the restriction requirement between the elected product and rejoined process claims will be withdrawn. It is submitted that the method claim as presented requires all the limitations of the elected product (pharmaceutical composition) claims. Thus, if the product claims are found allowable, the non-elected method of use claim (withdrawn) should be rejoined.

Applicants invite the Examiner to contact the Applicants' undersigned representative at (312) 913-0001, if the Examiner believes that a discussion would expedite prosecution of this application.

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Respectfully submitted,

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